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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,180

10/28/2003

Mike Kappes

BP 1986DIV

4291

7590

03/12/2004

James A. Harrison
P.O. Box 670007
Dallas, TX 75367

EXAMINER

KINKEAD, ARNOLD M

ART UNIT

PAPER NUMBER

2817

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,180

Applicant(s)

KAPPES ET AL.

Examiner

Arnold M Kinhead

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 and 17-28 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Objections

1. Claims 16-18 are objected to because of the following informalities: these claims are dependent from claim 12, however, they should depend from claim 15 the independent method claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following lack proper antecedent basis:

In claim 8, line 1, “ the RC time constant” ;

On line 4, “ reset number” is claimed, is this the same reset number in line 3?

In claim 12, lines 2-3, and claim 13, lines 2-3, “ the capacitance” .

The dependent claims 9-11, and 14 are indefinite by virtue of their dependence on claim 8 as rejected.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15,17,18, 19 , 20 , and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Takashima (US 5,180,991).

The reference by Takashima discloses an RC oscillator, see figure 2, with means for adjusting the time constant(RC) of the oscillator(14,16-1,2,3, and 20-n). a count value is generated and received by way of counter(32) and logic elements 26-n, 28. the time constant is indirectly determined by way of counting the oscillator output clock(see col. 5, line 45-col. 6, line 37). If it is determined that the RC time constant is low, then the capacitance will be incremented.

Note that the frequency of the clock output=1/RC, i.e. inversely related to the time constant. If it is high (again depending on the target frequency, see col. 5 as noted above) then the capacitance will be decreased. Note in col. 5, last paragraph, if the clock is at ½ the target frequency, and thus the initial first value of capacitance is set allow for this, the capacitance may be changed to a maximum value by virtue of the counter output and the desire to reach the target frequency. Likewise, the capacitance may be changed to a minimum value depending on the counter output and desire to reach the target frequency. The oscillation frequency is determined to be higher or lower than the target frequency by counting the output clock pulses, and thus the RC time constant can be indirectly determined to be low or high as a result. The capacitance array has a minimum, maximum and mid capacitance value range that may be

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set accordingly as the initial value due to the counter output and selection switches that are present. This may be achieved by way of setting the target frequency to allow for the initial $\frac{1}{2}$ total capacitance amount. Thus the method steps are inherent to such an apparatus.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 22-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,639,479. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite an integrated clock, albeit, the application claims remove the "clock" term from the preamble (see application claim 22, and patented claim 1) and places it in the body of the claim. Both sets of independent claims are still reciting essentially an integrated clock device/system that includes the transconductor, capacitive element, and comparator...The dependent claims also reciting similar aspects in both the application and patent...The patent claims 1-7 anticipates the elements as recited in the current application.

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Allowable Subject Matter

7. Claim 16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The examiner could not find fair suggestion for determining if the change included a minimal step size.

8. Claims 8-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The examiner could not find fair suggestion for the counter and master counter with rest number as claimed with rest of the integrated RC clock claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnold M Kinhead whose telephone number is 571-272-1763. The examiner can normally be reached on Mon-Fri, 8:30 am -5 pm.

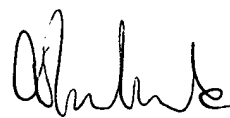
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pascal can be reached on 571-272-1769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Arnold M Kinkead', with a stylized, cursive script.

Arnold M Kinkead

Primary Examiner

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Arnold Kinkead

March 04-2004